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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/560,914	12/16/2005	Dieter Adolf Kluger	1823.001	2474
23598 7590 09/05/2008 BOYLE FREDRICKSON S.C. 840 North Plankinton Avenue MILWAUKEE, WI 53203				
EXAMINER STEPHENSON, DANIEL P				
ART UNIT 3676		PAPER NUMBER		
NOTIFICATION DATE 09/05/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@boylefred.com

Office Action Summary

Application No.

10/560,914

Applicant(s)

KLUGER ET AL.

Examiner

DANIEL P. STEPHENSON

Art Unit

3676

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-7 and 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the pre-grant publication to Bode (US 2003/0021922). Bode '922 (Fig. 2-4) discloses a well screen that includes; a base pipe (24); an inner cylindrical stand-off made of a skeletal mesh (17); a filter layer around the inner stand-off (18); an outer cylindrical stand-off around the filter layer (19); and a cover around the outer stand-off. The stand-offs provide a cage around the filter layer, have a greater rigidity and are arranged to provide structural resistance to collapse of the cover towards the filter. The longitudinal edges of the mesh stand-off are connected together. The outer cover is capable of collapsing, even though it may resist it, if well pressure is high enough. In addition, it is noted by the examiner, that if a layer is located below another layer, then it will inherently resist collapse of the layer above it. The stand-off layer is a mesh of orthogonally disposed rods, which are welded together at their ends. The outer layer is a tube created from a perforated metal sheet (para. 33).

Bode '922 shows all the limitations of the claimed invention, except, it does not disclose that the distance between the filter layer and the outer cover is 2.5-3mm, nor does it explicitly disclose that the outer cover has a construction that is less rigid than the outer stand-off layer. It would have been obvious to one of ordinary skill in the art at the time the invention was made to

use a stand-off of this thickness, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimal or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. In addition, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use an outer cover that was less rigid than the outer stand-off layer. As seen in figure 6, the outer layer is made from a thin sheet of material as compared to the thicker outer filter layer (20). Thus, when dealing with varying degrees of downhole pressure, and diameters, the outer cover will become less rigid than the outer stand-off layer upon final installation.

Response to Arguments

3. Applicant's arguments filed 8/22/08 have been fully considered but they are not persuasive. It is the assertion of the applicant that the outer shroud of Bode has a construction that is more rigid than the outer stand-off layer of Bode, because the outer cover is disclosed to "withstand downhole pressures". The examiner agree that this is the disclosure of Bode, but does not agree that his statement equates with the outer cover having a more rigid construction than the outer stand-off layer. As seen in Fig. 6, the outer cover has a very small thickness in comparison with the outer stand-off layer, thus implying a less rigid construction as they are disclosed as being made from the same material (para. 32). In addition downhole pressure in a wellbore has a very large variation depending on the well. An outer cover that can "withstand downhole pressures" need not be that strong at all.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL P. STEPHENSON whose telephone number is (571)272-7035. The examiner can normally be reached on 8:30 - 5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer Gay can be reached on (571) 272-7029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jennifer H Gay/
Supervisory Patent Examiner, Art Unit
3676

DPS